

JP



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/630,914	07/31/2003	Shlomo Ben-Shoham	1268-198	7569
------------	------------	-------------------	----------	------

22429 7590 02/09/2005

LOWE HAUPTMAN GILMAN AND BERNER, LLP  
 1700 DIAGONAL ROAD  
 SUITE 300 /310  
 ALEXANDRIA, VA 22314

EXAMINER

WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding..

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/630,914	BEN-SHOHAM, SHLOMO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jamila O Williams	3722	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on amendment filed 19 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-14-2004</u> . | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter of claim 18 ("wherein the first and second pegs can be disengaged only after said first and second side covers have been rotated away from each other by more than 180 degrees") constitutes new matter. This limitation is not supported by the original specification or figures. On page 4 line 17 of the specification applicant discloses that figure 5 shows the pegs in a "disengaged position" but there is no mention of rotating the side covers by more than 180 degrees. As a matter of fact in figure 5, the covers appear to be positioned at approximately 180 degrees.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The combination of the limitations recited in claims 19-20 and independent claim 11 is not clear. For example, claim 11 recites "at least a

Art Unit: 3722

pair of pegs including a first peg...and a second peg”, and then dependent claim 19 further recites “first and second U shaped members”. The combination of claims 11 and 19 suggest that the applicant is claiming a binder having both first and second pegs and U shaped members but this combination does not appear to be supported by the specification and figures. Claims 19-20 seem to be directed towards figure 6.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over 792,664 to Miller in view of 4,886,390 to Silence et al. Miller discloses a binder comprising a back cover (see figure 1 spine of book); left and right side covers (7,7) pivotally attached to opposing edges of the back cover, a pair of pegs (12,13) being attached to the right and left side covers (7,7), such that the length of the pegs vary during use according to an opening angle of the side covers (fig 2 and 3), as recited in claim 1. Miller further discloses that each peg is rotatable from an engagement position to an open position, where the peg is oriented substantially vertically to the respective side cover, as recited in claim 2 and means for keeping the pegs in open position (lines 30-35 and 50-105), as recited in claim 3. Miller discloses that one of the pegs has a hollow cavity and the second peg can be telescopically inserted inside the hollow cavity when the covers are moved closer together or drawn apart (fig 3), as recited in claim 4.

Art Unit: 3722

Miller also discloses two of the at least one pair of pegs, having a circular cross section and wherein one of the pegs is hollow and the other has an outside diameter smaller than the inside diameter of the hollow peg (fig 3, see pegs 12,13), as recited in claims 5 and 7-8. Miller does not however disclose that the pegs have a pivotal attachment to the side covers. Silence et al. provides a teaching for having a pivotal connection (elongated bores 26) between a binding ring (28) and a cover (18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the pivotal connection of Silence with the side covers of Miller for the purpose of allowing the pegs of Miller to pivot with respect to the side covers.

Regarding the limitation claim 6 wherein there are more than two pairs of pegs, it is old and well known to have ring binders that include two or more rings (in most cases 3 rings are provided, as can be seen in 5,018,896 to Vanni for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include two or more pairs of pegs (or rings) for the purpose of providing a more suitable binder for loose-leaf documents.

Regarding the limitation claim 9, wherein the outside diameter of the hollow peg is smaller than 5mm, Miller does not provide a teaching for the outside diameter of the hollow peg. However, it is well known that "standard perforation of documents using office punch produces circular holes 5mm in diameter", as applicant discloses on page 5 of the specification. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the outside diameter of the hollow

Art Unit: 3722

peg smaller than 5mm for the purpose of allowing the binder to accommodate standard office punch sheets.

Regarding the limitations of claims 11-12 are unpatentable over Miller in view of Silence et al, as applied to claim 1 above.

Regarding the limitation of claim 13, Miller discloses a spring biasing the first peg away from the engagement position (lines 30-35 and 50-105).

Regarding the limitations of claims 15-17, Miller discloses a first hollow peg and second peg that is received therein when the pegs are in the engaged position (when covers are rotated towards each other) and the pegs will be disengaged when the covers are rotated away from each other.

Regarding claims 19-20, these limitations are rejected as best understood in view of the 112 rejection above.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3722

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

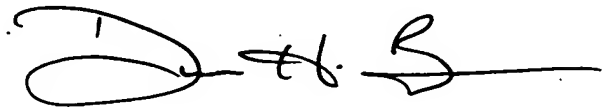
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday –Friday 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jw

A handwritten signature in black ink, appearing to read 'D. H. Banks', with a long horizontal line extending to the right.

**DERRIS H. BANKS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**